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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,328	09/29/2000	James A. Belmont	99104CON	1547

7590 10/04/2004
Michelle B Lando Esq
Cabot Corporation
Law Department
157 Concord Road
Billerica, MA 01821-7001

EXAMINER

OH, TAYLOR V

ART UNIT PAPER NUMBER

1625

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,328

Applicant(s)

BELMONT, JAMES A.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Final Rejection

The Status of Claims

Claims 1-27 and 29-31 are pending.

Claims 1-27 and 29-31 have been rejected.

Claim Rejections-35 USC 112

1. Applicants' argument filed 6/22/2004 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 1-27 and 29-31 under 35 USC 112 , first paragraph, has been withdrawn due to applicants' convincing arguments.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 1-27 and 29-31 under 35 USC 112 , second paragraph, has been maintained due to applicants' failure to modify in the amendment.

Claims 1-21 and (its dependent claims) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1-21, the phrases "a modified pigment product", "one steric group", "one organic ionic group", "one amphiphilic counter ion", are recited. This expressions of "a modified pigment product", "one organic ionic group", "one amphiphilic counter ion" are unclear because the claim does not describe how the pigment is modified and what the specific examples for "one steric group", "one organic ionic group", "one amphiphilic counter ion" can be for the final structure for the modified pigment. This rejection can be overcome by adding the specific examples of each components to the claim. An appropriate correction is required.

In claim 2, the phrase "R comprises" is recited. This expression of "comprises" is vague and indefinite. This is because what the meaning of the phrase "R comprises" is that the R may contain many additional components. The Examiner recommends to change from "R comprises" to "R is selected from the group consisting of". An appropriate correction is required.

3. The applicants argue the following issues:
 - a. With respect to the definitive structures, there are numerous locations in the application that describe the structure of each component and its relationship to the pigment at page 3 ,lines 15- page 4, line 28.
 - b. The expressions " comprising" and "comprises" are acceptable meaning under U.S. patent law; there is nothing indefinite with respect to claim 1.
 - c. The terms " spacer group", " functional group", " polymer" would understand clearly the meaning of each term in the specification.

First, with regard to the first argument, the Examiner agrees.

Second, with regard to the second argument, the Examiner has noted applicants' argument. However, the claim is directed to the single product ,not many products. The use of the expression of the term " comprising" in the compound claim may imply the presence of other compounds besides the only modified pigment product. This rejection can be overcome by changing from " comprising" and "comprises" to " having" and " is or contains ". An appropriate correction is required.

Third, with regard to the third argument, the Examiner has noted

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applicants' argument. However, the claim is directed to the single compound product. There are numerous examples for each of them. That is why this expression of " spacer group", " functional group", and " polymer" is vague and indefinite. They are components made-up for the final pigment product. There is uncertainty as to what the final pigment product would be like. This rejection can be overcome by adding those examples from the specification to the claims. An appropriate correction is required.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Taylor Victor Oh
9/28/04

Cecilia Tsang